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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/773,263	02/01/2001	Gerard K. Kunkel	WGATE11	4319

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EXAMINER	
BELIVEAU, SCOTT E	

ART UNIT	PAPER NUMBER
2614	

DATE MAILED: 09/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/773,263	KUNKEL ET AL.	
	Examiner	Art Unit	
	Scott Beliveau	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 June 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-30* is/are pending in the application.

4a) Of the above claim(s) *26-28* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-25,29 and 30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *06 June 2005* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 06 June 2005 has been entered.

Election/Restrictions

2. Newly submitted claims 26-28 are directed to an invention that is independent or distinct from the invention originally claimed. In particular, the originally presented claims were directed towards the generic system (Figure 1) and the species corresponding to the digital implementation of the ad insertion module (Figure 2A). Newly added claims 26-28 are directed towards the species corresponding to the analog implementation of the ad insertion module (Figure 2B).

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 26-28 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Priority

3. Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged. The examiner concurs with the applicant's arguments such that provisional application No. 60/191,474, filled 23 March 2000, provides support for claims 1-25 and 29-30. Accordingly, claims 1-25 and 29-30 shall be examined based on a priority date of 23 March 2000.

Drawings

4. The drawings were received on 06 June 2005. These drawings are approved.

Response to Arguments

5. Applicant's arguments with respect to claims 1 and 14 have been considered but are moot in view of the new ground(s) of rejection.

With respect to applicant's argument such that Stitnik fails to particular disclose or suggest the limitation such that the "terminal processor [is] programmed to compare each code for each selection in said information stream with said demographic information in said database, and determine therefrom whether said user is designated to receive said addition information related to said selection", the examiner respectfully disagrees. As noted by applicant Sitnik selects and displays an alternative image within a video sequence based on information in a user profile based upon information associated with the data packet corresponding to the selected image; however this information is argued as not used to determine if the user is designated to receive additional information related to the selected

image. The examiner respectfully notes that Stitnik further discloses that audio data may further correspond to the selected image (Figure 3 – S305). Accordingly, the claimed limitation is considered met such that additional information (ex. audio data) related to an information selection (ex. image data) is further determined by the terminal processor to be received.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1, 14, and 29 are rejected under 35 U.S.C. 102(e) as being anticipated by Sitnik (US Pat No. 6,160,570).

In consideration of claims 1 and 14, the Sitnik reference discloses a "system" and "method for transmitting information in a broadcast distribution system that is targeted to a system user" (Abstract). The system comprises a "network headend" [4], a "distribution network" [5/6], and a "plurality of terminal devices interfaced to said distribution network" [2] (Figure 1). The "network headend" through a "distribution network" [5/6] "transmits at least one information stream to a plurality of users" wherein "said information stream" is "comprised of a plurality of information selections and a plurality of corresponding codes . . .

identifying a characteristic of a corresponding one of said selections that is employed to identify a system user to whom additional information should be transmitted" (Col 3, Line 34 – Col 4, Line 34). The "plurality of terminal devices" [2], as illustrated in Figure 2, comprises a " terminal processor" [19] and a "user demographic database that contains demographic information about a corresponding user of said terminal device" [22] (Col 6, Line 34-43; Col 7, Line 41 – Col 8, Line 18). Upon receiving the aforementioned "information stream with said codes", the "terminal processor" [19] "compares each code for each selection in said information stream with said demographic information in said database and determine[s] . . . whether said user is designated to receive said additional information related to said selection" (Figure 3; Col 8, Line 19 – Col 9, Line 56).

Claim 29 is rejected wherein the "user demographic database" [22] is "adapted to be private to said terminal device and not shared with said network headend and said distribution unit" in light of the embodiments wherein the profile is generated through an on-screen questionnaire or based upon passive monitoring and the advertisement selection is performed entirely locally such that it need not be nor is disclosed as being accessible to the public at large (Col 7, Line 66 – Col 8, Line 18).

8. Claims 1-6, 14-19, 25, and 30 are rejected under 35 U.S.C. 102(a) as being anticipated by Maillard et al (EP 963 119 A1).

In consideration of claims 1 and 14, the Maillard et al. reference discloses a "system" and "method for transmitting information in a broadcast distribution system that is targeted to a system user" (Abstract). As illustrated in Figure 1, the system comprises a "network headend" [110/150/170], a "distribution network" [120], and a "plurality of terminal devices

interfaced to said distribution network" [160] (Para. [0038] – [0041]). The "network headend" through a "distribution network" [120] "transmits at least one information stream to a plurality of users" wherein "said information stream" is "comprised of a plurality of information selections" corresponding to interactive commercials (Para. [0046]) and a plurality of corresponding codes . . . identifying a characteristic of a corresponding one of said selections that is employed to identify a system user to whom additional information related to said selection" such as that corresponding to a particular coupon offer "should be transmitted" (Para. [0025] and [0052]). The "plurality of terminal devices" [160] comprising a " terminal processor" and a "user demographic database that contains demographic information about a corresponding user of said terminal device" and upon receiving the aforementioned "information stream with said codes", "compares each code for each selection in said information stream with said demographic information in said database and determine[s] . . . whether said user is designated to receive said additional information related to said selection" (Figures 2, 3, and 5; Para. [0042] – [0044], [0051] – [0055], and [0080]).

Claims 2, 15, and 25 are rejected wherein "said headend further includes an encoder" in accordance with the MPEG-2 standard for "generating said codes and inserting said codes into said information stream one each before a corresponding one of said selection" (Para. [0003] and [0006]).

Claims 3 and 16 are rejected wherein "said information stream is a video information stream, said broadcast distribution system is a cable television distribution system, and said terminal devices are each a set top converter box" (Para. [0041] – [0044])

Claims 4 and 17 are rejected wherein the "said information selections includes advertisements" such as broadcast commercials (Para. [0046] and [0081]).

Claims 5 and 18 are rejected wherein the "terminal processor is further programmed to provide a prompt to a corresponding user if said processor determines that said user is designated to receive said additional information" (Figure 5; Para. [0045] and [0048])

Claims 6 and 19 are rejected wherein the "headend" further comprises a "database containing said additional information that is to be made available to selected system users, based on the demographic information in the user demographic database" [150] (Para. [0040], [0046], and [0079]).

Claim 30 is rejected wherein the "prompt is embedded in said information stream" as distributed as part of the interactive application (Figure 3)

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the

time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 7-12 and 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maillard et al (EP 963 119 A1) in view of Wachob (US Pat No. 5,155,591).

With respect to claims 7 and 20, the Maillard et al. reference fails to particularly disclose or suggest the further targeting of "information selections" or commercials. Wachob et al. discloses a system and method for providing targeted television commercials. The system comprises a "headend [that] includes a multiplexer" [72] for "simultaneously transmitting a plurality of said information streams on a plurality of corresponding downstream channels that are interfaced between said distribution network and said terminal devices, [wherein] each said information streams includes information selections that are targeted to different user demographics". Each "terminal processor . . . is programmed to determine a selected one of said downstream channels on which a selected information selection targeted to a user of said terminal device is to be received and accesses said selected information selection" (Figure 3; Col 6, Line 27 – Col 7, Line 12). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so as to modify Maillard et al. as taught by Wachob for the purpose of advantageously targeting specific commercial advertisements or "information selections" to demographically selected audiences (Wachob: Col 1, Lines 25-30).

Claims 8, 9, 21, and 22 are rejected wherein the "terminal device" [10] of Wachob further comprises a "tuner for selecting a one of said downstream channels to receive" [18] and the "terminal processor" [30] is "further programmed to instruct said tuner to tune to said

selected one of said downstream channels to receive said selected information selection" and to "instruct said tuner to tune to back to a previously selected channel after a designated one of said selections has been received" (Wachob: Figure 3; Col 6, Lines 47-68; Col 7, Lines 13-54).

Claims 10 and 23 is rejected wherein the "information streams include at least one group of information selections, each selection of which is simultaneously transmitted with the other selections in said group, and is targeted to users having different demographics than those of users to which the other selections in said group are targeted" (Wachob: Col 9, Line 20 – Col 10, Line 9; Col 10, Line 43 – Col 11, Line 8).

Claim 11 is rejected wherein the "headend further includes an insertion module for inserting said groups of information selections into said information streams" [60] (Wachob: Col 9, Lines 20-56).

Claim 12 is rejected wherein "each information selection in said groups comprises an advertisement" (Wachob: Col 4, Lines 26-55).

12. Claims 13 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wachob (US Pat No. 5,155,591) in view of Bryant et al. (US Pat No. 5,652,615).

In consideration of claims 13 and 24, the combined references reference does not explicitly disclose nor preclude the usage of digital distribution techniques wherein "each information selection" or commercial is "transmitted in a different PID of a common digital channel". The Bryant et al. reference discloses a method for delivering targeting advertising wherein "each information selection is transmitted in a different PID of a common digital channel" (Col 5, Line 41 – Col 7, Line 17). Accordingly, it would have been obvious to one

having ordinary skill in the art at the time the invention was made so as to modify the Wachob targeted advertisement distribution for the purpose of providing a means to distribute targeted advertisements in conjunction with an upgraded (ex. analog-to-digital) distribution network (Bryant et al.: Col 1, Line 55 – Col 2, Line 14). The particular usage of digital distribution techniques as opposed to analog further provides the commonly known advantage of enabling cable distributors to carry larger numbers of programming due to more efficient utilization of bandwidth. Furthermore, the particular usage of MPEG based distribution in conjunction with Wachob would further advantageously provide for the distribution of a greater number of commercials, hence more precisely targeted advertisements.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 571-272-7343. The examiner can normally be reached on Monday-Friday from 8:30 a.m. - 6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information

about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Scott Beliveau
Examiner
Art Unit 2614

SEB
September 18, 2005